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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KRISTEN L. BHATTI and SHAHZAD BHATTI

Appeal 2009-001986
Application 09/873,741¹
Technology Center 2400

Decided: November 9, 2009

Before JOSEPH L. DIXON, JEAN R. HOMERE, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed June 4, 2001. The real party in interest is Hewlett-Packard Development Company, LP.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-15 mailed August 23, 2007, which are all the claims pending. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

Appellants invented a system, method, and computer usable medium for providing technical support documents via the Internet on a peripheral device connected to a web server storing the requested technical support documents. (Spec. 1, ll. 6-8.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-15. Claims 1, 3, 7, 8, 9, and 10 are independent claims. Claim 1 is illustrative:

1. A method for selectively providing technical support documents from a web server having access to the requested technical support documents to a peripheral device that has printer, scanner and/or fax functionality via the internet, the peripheral device being of the type which is capable of executing activated operating events and having an associated web client with a stored default URL for accessing the web server, the method comprising the steps of:

activating an event on the device;

requesting the default uniform resource locator with the activated event; and

returning to the device one or more of the technical support documents that relate to the activated event of the requested uniform resource locator.

C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Sullivan	US 6,615,240 B1	Sep. 2, 2003
Colby	US 6,625,643 B1	Sep. 23, 2003
Parupudi	US 6,859,829 B1	Feb. 22, 2005

D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by Colby;
- (2) Claims 3-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Colby in view of Sullivan; and
- (3) Claims 8-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Colby in view of Sullivan and further in view of Parupudi.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Colby

1. In Colby, “[t]he scheduler performs the event scheduling when a publisher schedules an event (broadcast).” (Col. 3, ll. 38-39.)
2. In Colby, “[c]licking on the event name will produce a report of resources allocated to and used by the event.” (Col. 24, ll. 2-4.)

Sullivan

3. Sullivan discloses that “[t]he display of this error message has prompted the user to request technical support.” (Col. 7, ll. 49-50.)

Parupudi

4. Parupudi discloses that “personal computers typically include other peripheral output devices (not shown), such as speakers and printers.” (Col. 4, ll. 16-18.)

III. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (internal citations omitted).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

IV. ANALYSIS

102(e) Rejection

Appellants contend that “Colby’s broadcast events are also represented from a network server and have no relevance or similarity to error events that occur in a peripheral device.” (Reply Br. 2.) Appellants further contend that in Colby “[a] line-by-line comparison shows that there is no mention of returning technical documents as claimed.” (App. Br. 12.)

The Examiner found that Colby discloses a “response message is received matching the Event ID” (Ans. 11).

Issue: Have Appellants shown that the Examiner erred in finding that Colby discloses “activating an event on the device” and “returning to the device one or more of the technical support documents that relate to the activated event”?

In essence, Appellants contend that Colby fails to disclose that the “activated event” is activated “on the peripheral device,” and a document is returned relating to the activated event. We agree.

Although the Examiner has directed our attention to numerous sections of Colby to disclose a peripheral device that has an event activated thereon (Ans. 4 and 11-12), it is unclear from our review of Colby and the Answer what the Examiner is actually relying on as representing the peripheral device and the event activated thereon. As such, we are left to speculate as to where such features are shown.

Independent claims 1 and 3 specifically call for “the device” to have printer, scanner and/or fax functionality via the Internet. The Examiner has

not shown, and we do not readily find such a peripheral device in Colby that has an event activated thereon.

In Colby, the broadcasted presentation is the “event” (FF 1). While broadcasting of a presentation on a “monitor,” for example, can arguably be seen as “activating an event” on a peripheral device, the Examiner has not shown what document is returned relating to such a broadcast event. Nor has the Examiner shown any broadcasting of the event on a printer, scanner and/or fax having functionality via the Internet. In fact, the Examiner admits later (regarding claim 8) that “Colby and Sullivan do not explicitly teach a peripheral device having printer, scanner and/or fax functionality” (Ans. 8).

Although Claim 7 does not require that the device have a printer, scanner and/or fax functionality via the Internet, Claims 3 and 7 do require that the “event” produce an error. The Examiner found that “Colby teaches clicking on the event name will produce a report used by event [sic]” (Ans. 4). We find that the Examiner has failed to show any correlation between Colby’s “report” and a “produced error.” Instead, Colby merely discloses that the report shows resources allocated to and used by the event (FF 2). In other words, Colby’s report relates to allocation of resources. In fact, the Examiner admits later (regarding claim 3) that “Colby does not explicitly teach produced an error [sic].” (Ans. 6).

Thus, Appellants have persuaded us of error in the Examiner’s conclusion of anticipation for representative claims 1, 3, and 7 which all recite the limitations discussed above. Therefore, we reverse the Examiner’s § 102 rejection of independent claim 1, 3, and 7 and of dependent claims 2 and 4-6, which stand therewith.

103(a) Rejections

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

Claims 3-5

Here, the Examiner continues to rely on Colby and also imports Sullivan merely to illustrate an event producing an error (Ans. 5-6). Thus, the Examiner is not relying on Sullivan to cure Colby's deficiencies noted above regarding the peripheral device having a printer, scanner and/or fax functionality via the Internet.

As a result, and for at least the reasons set forth *supra*, we find that the Examiner has not established, and even admits that the combination of Colby and Sullivan fails to disclose the argued "peripheral device" features as set forth in independent claim 3.

Thus, Appellants have persuaded us of error in the Examiner's conclusion of obviousness for claim 3. Therefore, we reverse the Examiner's § 103 rejection of independent claim 3 and of claims 4 and 5, which stand therewith.

Claim 8

Appellants contend that "[o]ne of ordinary skill in the art understands that a database table is not a peripheral device state table as claimed." (App. Br. 17.)

The Examiner found that “Colby teaches [sic] obtain a most recently activated event from a device state table in a peripheral device” (Ans. 13.)

Issue: Have Appellants shown that the Examiner erred in finding that the cited references disclose “obtain a most recently activated event from a device state table in a peripheral device computer . . . is part of a peripheral device”?

As noted *supra*, the Examiner admits that the combination of “Colby and Sullivan do not explicitly teach a peripheral device having printer, scanner and/or fax functionality.” (Ans. 8). In an attempt to show this feature, the Examiner found that Parupudi discloses that personal computers typically include peripheral output devices such as printers (Ans. 8) (FF 4). However, the Examiner has not established that Parupudi discloses a device state table in such peripheral devices and obtaining a recently activated event from such state table, as set forth in claim 8.

Thus, Appellants have persuaded us of error in the Examiner’s conclusion of obviousness for claim 8. Therefore, we reverse the Examiner’s § 103 rejection of independent claim 8.

Claim 9

Appellants contend that “in Colby, the user is selecting an event name, which is a broadcast event. This has no relation to error events on a peripheral device.” (App. Br. 18.)

The Examiner found that “Parupudi teaches a peripheral device having printer, scanner and/or fax functionality. . . .” (Ans. 9.)

Issue: Have Appellants shown that the Examiner erred in finding that the combination of cited references discloses to “select an event on a peripheral device where the event has produced an error message”?

In rejecting claim 9, the Examiner admits that both Colby and Sullivan do not explicitly teach a peripheral device having printer, scanner and/or fax functionality but reasons that Parudupi’s disclosed peripheral device can be used in the system of Colby (Ans. 9). However, we find that the Examiner has failed to identify how Parudupi’s peripheral devices can be used to select an event that has produced an error message. Instead, the Examiner has merely shown that peripheral devices are known. We agree that using peripheral devices are known. However, the Examiner has not established that Parupudi teaches peripheral devices that can be used to select an error event thereon. Nor has the Examiner shown and we do not readily find how the combination of Colby and Sullivan teaches or fairly suggests such a feature.

Thus, Appellants have persuaded us of error in the Examiner’s conclusion of obviousness for claim 9. Therefore, we reverse the Examiner’s § 103 rejection of independent claim 9.

Claims 10-15

Appellants contend that:

The cited portion of Colby relates to operation of a Topology Manager, which is a program. A program is not a peripheral device. Colby does not teach or suggest a peripheral device being configured to request, in response to an error event, a relevant technical support document from a web server using a default uniform resource locator.

(App. Br. 19)(internal citations omitted.)

The Examiner found that Colby teaches to “create a default page for the event.” (Ans. 10.)

Issue: Have Appellants shown that the Examiner erred in finding that the combination of cited references disclose “the peripheral device being configured to request, in response to an error event, a relevant technical support document”?

Here, we find that the Examiner is relying on Colby’s broadcast events (FF 1-2), Sullivan’s error message (FF 3), and Parudupi’s peripheral device (FF 4). However, the Examiner has not shown how the combination of references fairly suggests a peripheral device being used to select an event thereon, where the event has produced an error message. Instead, we find the Examiner has relied upon mere piecemeal locating of words in the references without any articulated reasons for arriving at the claimed invention. Furthermore, the Examiner has not established that using a peripheral device to select error events thereon is merely a predictable use of known elements according to their established functions.

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Thus, Appellants have persuaded us of error in the Examiner's conclusion of obviousness for claim 10. Therefore, we reverse the Examiner's § 103 rejection of independent claim 10 and of claims 11-15, which stand therewith.

V. CONCLUSION

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-15.

VI. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-15.

REVERSED

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